REMARKS

At the time of the Office Action dated May 14, 2007, claims 1-18 were pending and rejected in this application. Claims 1, 7, and 13 have been amended, and claims 2, 8, and 14 have been cancelled. Care has been exercised to avoid the introduction of new matter. Specifically, claims 1, 7, and 14 have been amended by incorporating the limitations of claims 2, 8, and 14, respectively. Applicant submits that the present Amendment does not generate any new matter issue.

CLAIMS 1-6 ARE REJECTED UNDER 35 U.S.C. § 101

On page 2 of the Office Action, the Examiner asserted that the claimed invention, as recited in claims 1-6, is directed to non-statutory subject matter. This rejection is respectfully traversed.

On page 2 of the Office Action, the Examiner asserted the following with regard to the claims:

> Claims 1-6 are drawn to a computer program per se. A computer program is not a series of steps or acts and this is not a process. A computer program is not a physical article or object and as such is not a machine or manufacture. A computer program is not a combination of substances and therefore not a compilation of matter. Thus, a computer program by itself does not fall within any of the four categories of invention. Therefore, Claims 1-6 are not statutory.

Based upon the Examiner's analysis, it is readily apparent that the Examiner misunderstands exactly what constitutes software *per se*. In particular, Appellants respectfully submit that the Examiner is confused as to exact meaning of the phrase "per se." The definition

of "per se" is the following:[1]

> By itself; in itself; taken alone; by means of itself; through itself; inherently; in isolation; unconnected with other matters; simply as such; in its own natures without reference to its relation.

Thus, software *per se* is an abstract idea embodied by the software alone without anything else.

For this reason, software *per se* is deemed to be non-statutory subject matter.

For example, the claim at issue within In re Warmerdam was to a data structure, *per se*. Specifically claim 6 recited "[a] data structure generated by the method of any of Claims 1 through 4." Thus, claim 6 of In re Warmerdam was directed to a data structure, in isolation. Claim 1 of the present application, however, is not directed to either a data structure or computer program, in isolation.

The claimed invention is directed to a system/device. Specifically, the claimed system includes <u>functional</u> components (e.g., "a processor for executing said software instructions on the client machine"). Software, *per se*, is <u>incapable</u> of being functional since software, *per se*, is unconnected to anything else. Because the claimed system includes functional components, the system must include and/or be coupled to physical components (i.e., hardware) to be functional. Therefore, the claimed system constitutes statutory subject matter within the meaning of 35 U.S.C. § 101. Applicant, therefore, respectfully solicits withdrawal of the imposed rejection of claims 1-6 under 35 U.S.C. § 101.

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[1] Black's Law Dictionary 1142 (6th ed. 1990).

CLAIM 4 IS REJECTED UNDER THE SECOND PARAGRAPH OF 35 U.S.C. § 112

On pages 2 and 3 of the Office Action, the Examiner identified a perceived informality

generating an antecedent basis issue. This rejection is respectfully traversed.

Independent claim 1, upon which claim 4 indirectly depends, has been amended to

include the term "a Java applet." Thus, proper antecedent basis is provided for the term "the Java

applet" in claim 4. Applicant, therefore, respectfully solicits withdrawal of the imposed rejection

of claim 4 under the second paragraph 35 U.S.C. § 112.

CLAIMS 1-3, 5-9, 11-15, AND 17-18 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON SAIDENBERG ET AL., U.S. PATENT PUBLICATION NO. 2004/0003347 (HEREINAFTER SAIDENBERG)

On pages 3-5 of the Office Action, the Examiner asserted that Saidenberg discloses the

invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical

disclosure, either explicitly or inherently, of each element of a claimed invention in a single

reference.[2] Moreover, the anticipating prior art reference must describe the recited invention

with sufficient clarity and detail to establish that the claimed limitations existed in the prior art

and that such existence would be recognized by one having ordinary skill in the art.[3] As part of

this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the

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[2] In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).
[3] See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.[4] This burden has not been met.

Claims 1, 7, and 13 have each been amended to clarify that the software instructions are disposed in a Java applet. On page 3 of the Office Action, the Examiner cited paragraph [0100] of Saidenberg as identically disclosing the claimed "said software instructions calling the script to retrieve user interface properties." Referring to paragraph [0100], Saidenberg teaches that "to access the style sheet file, the application code instructions may include the javascript file ols.js in all HTML pages." On page 4 of the Office Action, the Examiner cited paragraph [0048] as teaching that the software instructions are disposed in a Java applet, as claimed.

Although paragraph [0048] refers to the browser running Java applets, the Examiner has not factually established that the software instructions, which are in a Java applet, also call a script to retrieve user interface properties. Instead, Saidenberg teaches that HTML pages use a script to access a style sheet file. Thus, one having ordinary skill in the art would not recognize that Saidenberg identically discloses the claimed invention, as recited in claims 1, 7, and 13, within the meaning of 35 U.S.C. § 102. Applicant, therefore, respectfully solicits withdrawal of the imposed rejection of claims 1, 3, 5-7, 9, 11-13, 15, and 17-18 under 35 U.S.C. § 102 for anticipation based upon Saidenberg.

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[4] Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

CLAIMS 4, 10, AND 16 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON SAIDENBERG

On pages 5 and 6 of the Office Action, the Examiner asserted that one having ordinary skill in the art would have been motivated to modify Saidenberg to arrive at the invention corresponding to that claimed. This rejection is respectfully traversed.

Claims 4, 10, and 16 depend ultimately from independent claims 1, 7, and 13, and Applicant incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 1, 7, and 13 under 35 U.S.C. § 102 for anticipation based upon Saidenberg. Applicant, therefore, respectfully submits that the imposed rejection of claims 4, 10, and 16 under 35 U.S.C. § 103 for obviousness based upon Saidenberg is not viable and, hence, solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

> When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the

claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: August 14, 2007   Respectfully submitted,

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